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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/808,919 | 03/24/2004 | Saurav Paul | 001-040901US | 8077 |
| 33486 | 7590 | 04/20/2007 | EXAMINER | |
| HEIMBECHER & ASSOC., LLC | | | VRETTAKOS, PETER J | |
| P O BOX 33 | | | ART UNIT | PAPER NUMBER |
| HAMEL, MN 55340-0033 | | | 3739 | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 04/20/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/808,919 | PAUL ET AL. | |
| | Examiner | Art Unit | |
| | Peter J. Vrettakos | 3739 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 January 2007.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-84 is/are pending in the application.
 4a) Of the above claim(s) 2-64 and 83-84 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1 and 65-82 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>7-16-04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

The application is published application number: 2005/0159739. The publication is classified in US 606/41.

The Applicant is requested to provide (or check for accuracy) at the beginning of the Specification updated status information (serial numbers and patent numbers) of all related applications.

Elected (traversed) claims 1 and 65-82 are examined below.

Applicant's election with traverse of Group I is acknowledged. The traversal is on the ground(s) that no burden is shown. This is not found persuasive because the groups represent separate inventions and not merely obvious variants. Consistent with this, the Applicant has filed over **forty** figures depicting separate distinct inventions.

Also see:

35 U.S.C. 121 Divisional applications

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 7-16-04 is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 77 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicant is requested to show where in the original disclosure is an annular layer of porous material.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1 and 65-68, 72, 75-77 and 79-82 are rejected under 35 U.S.C. 102(b)
as being anticipated by Goble et al. (6,780,180).**

Note: specific references in the patented disclosure below are not limiting to those excerpts. (The Office reserves the right in future actions to apply other excerpts, need be, from the patent.)

The patent discloses:

A catheter comprising an outer sheath (12), inner sheath (16), annular channel (17), a porous (figure 13 – fluid 17 emitted through 15 out of distal element 13) mechanical interface (15), clustered (54, figure 7b) hollow and wire electrodes (11; col. 25:36-37; 14 in figure 2) with embedded and exposed portions (depicted in figure 7a and 7b) and conductive core (14a), a primary conductor (14), a porous (see figure 12d – element 96 permits emission of fluid thereby is porous) flexible boot (86,96),

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 73-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goble et al. (6,780,180).

Looped primary conductors as claimed are merely rearrangement of parts found in Goble and are further a mere obvious design choice.

The courts have held analogous inventions obvious: *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.). Applied to the instant invention, a looped primary conductor as claimed and seen in Applicant's figure 26 would not have modified the operation of the claimed device or that seen in Goble. See MPEP § 2144.04.

Claims 69-71 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goble et al. (6,780,180) in view of Wilsdorf (4,358,699).
Goble is silent regarding non-conductive fibers of varying length. (Goble does disclose conductive filaments of different lengths (54 in figure 7a,b).)

Wilsdorf discloses brush electrodes with varying filament lengths, as well as non-conductive filaments (non-metallic support fibers 24, col. 28:63-64) interspersed/embedded with conductive filaments (21). The patent is replete with suggestions for varying the fibers in a brush electrode to suit whatever the application dictates.

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Goble in view of Wildorf by determining the optimal filament design as part of the Goble brush electrode to best suit the application of the device. Wilsdorf discloses numerous statements in the patent to this effect (design the fibers as best suited for the application) for example in col. 27:28-31.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos
April 12, 2007



ROY D. GIBSON
PRIMARY EXAMINER